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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,801	12/08/2005	Hiroaki Tsutsumi	SHIGA5.004APC	8174
20995 7590 12/22/2009 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER HYLTON, ROBIN ANNETTE				
ART UNIT 3781		PAPER NUMBER		
NOTIFICATION DATE 12/22/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
eOAPilot@kmob.com

# Office Action Summary

**Application No.**

10/559,801

**Applicant(s)**

TSUTSUMI ET AL.

**Examiner**

ROBIN HYLTON

**Art Unit**

3781

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI.08)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 4, 2009 has been entered.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with

this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 and 3-13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 7,264,131. Although the conflicting claims are not identical, they are not patentably distinct from each other because each discloses a cap having a cap body, a circular inner seal projection, a circular opening edge seal projection, and a positioning protrusion provided on a top plate of the cap body. The instant claims are silent regarding the threaded portion, but further set forth details of the positioning protrusion. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the instant claims with more specific details of the positioning protrusion of the cap as an alternative manner of claiming the inventive cap.

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1 and 3-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kano et al. (US 6,779,672) in view of Thompson (US 6,126,027).

Kano discloses a synthetic resin cap in the embodiment illustrated in Fig. 5 comprising a cap body having a top plate (104) and a cylindrical section extending downward from a periphery of the top plate (106); a circular inner seal projection (134) formed on an inner surface of the top plate which fits into a container opening; and a circular opening edge seal projection (132) formed on the inner surface of the top plate, and wherein a positioning protrusion (136) is

provided on the top plate that contacts the opening edge when the opening edge seal projection is bent and deformed, and wherein the positioning protrusion is integrated with the inner seal projection so as not to have a gap therebetween in the radial direction of the synthetic resin cap, and wherein the positioning protrusion is configured so as to maintain a predetermined position thereof in relation to the top plate, whether or not the inner seal projection is bent and/or deformed. Kano teaches the circular opening edge seal projection (132) is flexible and bends (col. 15, lines 28-30), but is silent regarding the opening edge seal projection is bent and deformed in an expanding radial direction until **contacting the cap body** when the synthetic resin cap is attached to the container opening and **contacts an opening edge** of the container opening.

Thompson teaches it is known to provide a synthetic cap with an opening edge seal projection which is bent and deformed in an expanding radial direction **until contacting** the cap body when the synthetic resin cap is attached to a container opening and contacts an opening edge of the container opening (see Fig. 2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of the opening edge seal projection being flexible so as to be bent and deformed in an expanding radial direction until contacting the cap body when the synthetic resin cap is attached to the container opening and contacts an opening edge of the container opening. Doing so provides an additional seal between the container opening and the cap to prevent degradation of the container contents.

6. Claims 1 and 3-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson (US 6,126,027) in view of Kano et al. (US 6,779,672).

Thompson discloses a synthetic resin cap comprising a cap body (10) having a top plate (11) and a cylindrical section (12) extending downward from a periphery of the top plate; a circular inner seal projection (30) formed on an inner surface of the top plate which fits into a container opening; and a circular opening edge seal projection (18) formed on the inner surface of the top plate which contacts an opening edge of the container opening, wherein the opening edge seal projection is bent and deformed in an expanding radial direction until contacting the cap body when the synthetic resin cap is attached to the container opening (see Fig. 2). Thompson does not disclose a positioning protrusion is provided on the top plate that contacts the opening edge when the opening edge seal projection is bent and deformed until contacting the cap body, and wherein the positioning protrusion is integrated with the inner seal projection so as not to have a gap therebetween in the radial direction of the synthetic resin cap, and wherein the positioning protrusion is configured so as to maintain a predetermined position thereof in relation to the top plate, whether or not the inner seal projection is bent and/or deformed.

Kano teaches it is known to provide a synthetic resin cap comprising a positioning protrusion (136) provided on a top plate that contacts the opening edge of a container when the opening edge seal projection is bent and deformed until contacting the cap body, and wherein the positioning protrusion is integrated with the inner seal projection so as not to have a gap therebetween in the radial direction of the synthetic resin cap, and wherein the positioning protrusion is configured so as to maintain a predetermined position thereof in relation to the top plate, whether or not the inner seal projection is bent and/or deformed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of a positioning protrusion on the top plate that contacts the opening edge when the opening edge seal projection is bent and deformed until contacting the cap body,

and wherein the positioning protrusion is integrated with the inner seal projection so as not to have a gap therebetween in the radial direction of the synthetic resin cap, and wherein the positioning protrusion is configured so as to maintain a predetermined position thereof in relation to the top plate, whether or not the inner seal projection is bent and/or deformed. Doing so provides for centering the cap upon the container mouth and maintaining a correct spacing for ensuring the inner seal projection properly engages the inner surface of the container opening.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1 and 3-13 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

8. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F.R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Various prior art closures teaching features similar to those disclosed and/or claimed are cited for their disclosures.

10. In order to reduce pendency and avoid potential delays, Group 3720/80 is encouraging FAXing of responses to Office Actions directly into the Group at (571) 273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into Group 3720/80 will be promptly forwarded to the examiner.

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11. It is called to applicant's attention that if a communication is faxed before the reply time has expired, applicant may submit the reply with a "Certificate of Facsimile" which merely asserts that the reply is being faxed on a given date. So faxed, before the period for reply has expired, the reply may be considered timely. A suggested format for a certificate follows:

I hereby certify that this correspondence for Application Serial No. \_\_\_\_\_ is being facsimiled to The U.S. Patent and Trademark Office via fax number 571-273-8300 on the date shown below:

Typed or printed name of person signing this certificate

Signature \_\_\_\_\_

Date \_\_\_\_\_

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robin Hylton whose telephone number is (571) 272-4540. The examiner can normally be reached Monday, Tuesday, Thursday, and Friday from 9:00 a.m. to 4:00 p.m. (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick, can be reached on (571) 272-4561.

Any inquiry of a general nature or relating to the status of this application or proceeding may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Other helpful telephone numbers are listed for applicant's benefit:

- Allowed Files & Publication (888) 786-0101
- Assignment Branch (800) 972-6382
- Certificates of Correction (703) 305-8309
- Fee Questions (571) 272-6400
- Inventor Assistance Center (800) PTO-9199
- Petitions/special Programs (571) 272-3282
- Information Help line 1-800-786-9199
- Internet PTO-Home Page <http://www.uspto.gov>

December 15, 2009

/Robin A. Hylton/  
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GAU 3781